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THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

Leonel Yanez MARTINEZ et al.)

Serial No. 10/613,433)

Group Art Unit: 2831

Filed: JULY 3, 2003)

Examiner: William Mayo II

Title: **DRY WATER RESISTANT
COAXIAL CABLE AND METHOD
OF MANUFACTURE THEREOF**)

Docket No. MX/JFServ-001)

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENT TO 37 C.F.R. § 1.181 PETITION

Sir:

Applicants submit the following supplementary petition regarding the withdrawal of the two new prior art cited by the Examiner dated in his Final rejection and Examiner Answer.

It is submitted that the citation of the new references was **not triggered by any act of the Applicants** that would entitle the Office to cite new references in the Final Rejection and Examiner Answer.

The Examiner cited a new prior art, Hughey, US 5,043,538 in the Final Rejection dated May 19, 2009 on page 14.

Again, the Examiner cited a new prior art, Midner, US 3,795,640 in the Examiner Answer on pages 26-27.

The Examiner indicated that Claims 71-72 and 74-75 were objected to because they render the claims "**indefinite**" in the Final Rejection dated May 19, 2009, item 3 on page 2. The Applicants filed an Appeal dated November 24, 2009 and argued that the claims are "**definite**." The Examiner Answer dated February 18, 2010 indicated that Claims 71-72 and 74-75 were

First, the Examiner has been **consistent** is rejecting the claims of the present application since the **first Non-Final Action dated 12-16-04**. The Examiner rejected the claims over **Chan (US5486648)**, **Goehlich (US6784371)** and **Belli (US6455769)** until **Non Final Action dated 12-7-08**. Then in the **Final Rejection dated 5/19/09**, issued a newly cited art **Hughey, US 5,043,438**. Applicants were **"surprised"** to receive a newly cited art and **did not** have an opportunity to respond properly to the rejection.

Second, the Examiner asserted to the Applicants that US20030060525, US6403889, US6282778, US20020189697, and US4204086 will be used in the rejection of the claims at the Examiner Interview dated 1-15-09.

Third, the claims were objected because they were indefinite (according to the Final Rejection dated 5-19-09). The Examiner stated in Examiner Answer that the objection is petitionable. Appellants believed the claims were indefinite under 35 U.S.C. § 112, second paragraph and appealable.


Fourth, the Examiner issued a newly cited prior art Hughey, US 5,043,438 in the Final Rejection.

Fifth, the Examiner issued a second newly cited art Midner, US3,795,640 in the Examiner's Answer. The Appellant did **not amend** the claims. The issuance of a new prior art **was not triggered by any action by Appellant**.

A new prior art reference applied or cited for the **first time** in an examiner's answer generally will constitute a **new ground of rejection**. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a **new ground of rejection**. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 (CCPA 1970).

It is submitted that Applicants were **not given** an opportunity to respond to the newly cited art in the Final Rejection and Examiner Answer. For the above reason, Applicants submit that the Petition to withdraw the newly cited prior be granted or provide an opportunity for Applicants to respond appropriately to the two newly cited art.

Respectfully submitted,


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objected to and were **not** rejected under 35 U.S.C. 112, although he stated that they render the claims **indefinite and should not be appealable, rather they are petitionable**.

The Applicants filed a petition Examiner called the Applicants and indicated that Claims have to be amended

RELEVANT PROSECUTION HISTORY

12/16/04 Non Final Action was mailed which follows:
Restriction requirement of Group I-Claims 11-27 directed to coaxial cable; and
Group II-method of making coaxial cable;
Applicant elected Group I.

Claims 11-27 were rejected under 35 U.S.C. § 112, second paragraph as being ***indefinite*** for failing to particularly point out and distinctly claim subject matter which applicant regards as invention.

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph for the limitation “conductor” in line 6 because it is confusing and renders claim ***indefinite***. It is unclear whether Applicant is referring to previously mentioned “core conductor” element or introducing new conductor.

Claim 21 was rejected under 35 U.S.C. § 112, second paragraph for the limitation “second reinforcement layer” in line 2 because it is confusing and renders claim ***indefinite***. Claim 21 was rejected for the limitation “swellable dielectric.”

Claims 11-13, 16-18, 20 and 23-25 were rejected under 35 U.S.C. §103 as being unpatentable over Chan (US5486648) in view of Goehlich (US6784371).

Claims 14-15, 19, 21-22 and 26-27 were rejected under 35 U.S.C. §103 as being unpatentable over Chan (US5486648) in view of Goehlich (US6784371) and further in view of Belli (US6455769).

3/21/05 Applicants responded to Office Action and argued about restriction requirement. Applicants argued that according to MPEP 821.04 if Group I was found allowable, it should be rejoined with Group II.

Applicants amended the claims in order to avoid 35 U.S.C. § 112, second paragraph rejection.

Applicants argued regarding the rejections of the claims under 35 U.S.C. §103 as being unpatentable over the cited prior art.

5/19/05 Final Rejection
The Examiner made the restriction requirement final.

The Examiner used the same rejections from the Non-Final Rejection dated 12/6/04.

Claims 11-13, 16-18, 20 and 23-23 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)**.

Claims 14-15, 19, 21-22 and 26-27 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)** and further in view of **Belli (US6455769)**.

8/10/05 Applicants responded to the rejections of the claims under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)** and further in view of **Belli (US6455769)**.

9/1/05 Advisory Action
The Examiner indicated that Applicants' arguments did not place the claims in condition for allowance

9-26-05 Notice of Appeal filed

12/21/05 Applicants filed a petition regarding the finality of restriction requirement

12/27/05 Appeal Brief filed

2-21-06 Defective Appeal Brief

3-23-06 Appeal Brief filed

6-19-06 Examiner Answer

7-21-06 Applicants request PTO on the Status of Petition filed on 12/21/05

8-14-06 Reply Brief filed

4-17-07 Petition decision-Petition denied on Restriction requirement

7-15-08 Board of Appeal decision-Affirmed Examiner

9-18-08 CPA/RCE filed
Claims 1-40 were cancelled; Pending Claims were 41-67

10-7-08 Non-Final Rejection

Claims 57-67 objected for improper dependent form. Claim 57 fails to limit the structure of Claim 41.

Claims 41-43, 46-48, 50, 53-54 and 57-67 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)**.

Claims 44-45, 49, 51-52, and 55-56 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)** and further in view of **Belli (US6455769)**.

Examiner stated the following at the end of Office Action

ORDER

Obviousness rejection of Claims 11-27 affirmed.

1-15-09 Examiner Interview
Applicants argued that claims were amended to closed ended language “**consisting**”
Examiner indicated that new prior art would be utilized in new rejection. Examiner informed Applicants of at least 6 references such as US20030060525, US6403889, US6282778, US20020189697, and US4204086.

2-12-09 Applicants responded to Office action. Claims 41-67 cancelled. Claims 68-76 were pending. Claims were amended to closed ended language “consisting”. Applicants argued that the limitation “**consisting**” which closes the claims to inclusion of materials other than those recited in claims except for impurities and “nothing more.”

Appellants stated in the response the same set of claims have been issued as **EP 1,457,996 on 3/21/07**

3-2-09 Office action requested a Complete listing of claims

3-9-09 Applicants responded to Office action. Claims 1-67 were cancelled. Pending claims were 68-76.
Applicants argued regarding the references provided by Examiner at the Examiner Interview. Applicants argued over US20030060525, US6403889, US6282778, US20020189697, and US4204086.

Similarly, Applicants argued that claims were amended with the limitation “**consisting**” which closes the claims to inclusion of materials other than those recited in claims except for impurities and “nothing more.”

5-19-09 Final Rejection

The Examiner indicated that he **objected** to Claims 71, 72, 74 and 75 because they were **indefinite**.

Claims 41-43, 46-48, 50, 53-54 and 57-67 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)**.

Claims 44-45, 49, 51-52, and 55-56 were rejected under 35 U.S.C. §103 as being unpatentable over **Chan (US5486648)** in view of **Goehlich (US6784371)** and further in view of **Belli (US6455769)**.

The Examiner **did not** cite the references which were discussed at the interview and Applicants' arguments on 3-9-09. **US20030060525, US6403889, US6282778, US20020189697, and US4204086.**

However, the Office action cited a **new reference Hughey, US 5043438.**

The Examiner indicated in Office Action that the prior art uses the limitation "**consisting**" language in the claims when clearly all of the prior art recites "**comprising**"

Finally, the Examiner stated at the end of the Office Action

CONCLUSION OF LAW

The Examiner has established obviousness rejection

ORDER

Obviousness rejection of the Claims affirmed.

8-12-09	Notice of Appeal & Pre-Appeal Request filed Petition on finality of restriction requirement
8-26-09	Petition Decision on restriction requirement denied
9-15-09	Preappeal decision-proceed to Board of Appeal
11-20-09	Appeal Brief filed Appellants argued that Claims 71, 72, 74 and 75 are definite under 35 USC 112, second paragraph and directed Examiner to pages in specification.
12-28-09	Revised Appeal Brief filed
2-18-10	Examiner Answer

The Examiner cited a list of cited prior art as **evidence relied on** as follows:

Chan (US5486648)

Goehlich (US6784371)

Belli (US6455769)

Hughey, US5043438

But did not include newly cited prior art Midner, US3,795,640 which was cited in the Examiner Answer at pages 26-27.

- 6-1-10 Petition to withdraw objections and new prior cited in Final Rejection and Examiner Answer.
Applicants petition that the cited new prior art in Final Rejection and Examiner Answer be withdrawn
- Applicants also indicated that Examiner alleged in Examiner Answer that the indefinite claims **were objected** to and were **not rejected** under 35 U.S.C. § 112, second paragraph.
- 6-2-10 Administrative Remand to Examiner
Petition issue remanded to Examiner
- 6-7-10 Reply Brief filed
- 6-14-10 Administrative Remand to Examiner
Reply Brief issue remanded to Examiner
Examiner stated that XOT is not allowed when filing Reply Brief
- 6-29-10 Examiner Interview Summary by Examiner
Examiner called Applicants and indicated that the **objected** claims should be amended before the application can be sent to Board of Appeals.
Examiner indicated that Applicants agreed to amendment of claims
- Appellants indicated that she will look at the claims and call Examiner.
Appellants did not agree to amendments.
- 7-1-10 Examiner Interview Summary by Applicant
At the interview, Appellants repeated the argument with the Examiner that the primary reference Chan, U.S. 5486648 employs concentric neutral wires (CNW) which are **stranded** and **non-continuous** while the external conductor of the present invention is **not stranded, continuous and solid all the way around and supports electric field**. This characteristic is important because **stranded, non-continuous wires will not provide the magnetic or electric path. It will impede current flow.** The current will not flow because the conductors are separate. CNW will not work in signal application as present invention.
In addition, Chan discloses **crosslinked polyethylene (XLPE)** such as ethylene vinyl acetate or EPR and are different materials while the **present invention** employs low density polyethylene (LDPE) and **are not crosslinked**. **Chan's crosslinking requires curing.** It is well known to one of ordinary skill in that art that the **curing process provides high heat resistance** and therefore **provides high dielectric**. The present invention has **LOW dielectric and low thermal extended properties** which provide **low capacitance for transmission properties**. If a material has **high dielectric** and placed in an electric field, the magnitude of the field will be **measurably reduced** within the volume of the dielectric. **XLPE is not functionally equivalent to LDPE**

The Examiner combined Chan with Goehlich (U.S. 6,784,371) and Belli et al. (U.S. '6,455,769) which are both directed to continuous wires. There is **no motivation or suggestion to combine Chan (non-continuous or stranded wires) with Goehlich and Belli which are continuous wires** in order to achieve the presently claimed invention. The invention is directed to communication cables and **not** power cables.

7-6-10 Examiner Interview Summary by Applicant

The Examiner made proposed amendments to Claims 71, 72, 74 and 75. Appellants indicated that she did not agree to amendments proposed by Examiner and would request the Board to determine if the claims that were **rejected** were indefinite under 35 U.S.C. § 112, second paragraph or **objected** to because they were indefinite.

7-14-10 Examiner Interview Summary by Examiner

The Examiner indicated that amendment of the claims will not put the claims in condition for allowance but the **claim objection would be withdrawn**. Applicants indicated that she will not amend the claims and let the Board decide if the claims were indefinite under 35 U.S.C. § 112, second paragraph or objected to because they were indefinite.

DISCUSSION

706.07(a) Final Rejection, when proper on Second action

Under present practice, second or subsequent action on the merits shall be **final**, except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment of claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97c with a fee set forth in 37 C.F.R. 1.17 (p).

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings **will not be made final if it includes a rejection, on newly cited art**, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

A second or subsequent action on the merits in any application or patent involved in reexamination proceedings **should not be made final if it includes a rejection, on prior art not of record**, of any claim amended to include limitations which should reasonably would have been expected to be claimed. See MPEP §904 et seq.

In this situation, the claims were rejected over **newly cited art** in the Final rejection and was evidence relied upon by the Examiner as indicated on page 4 of the Examiner Answer dated 2-18-10. It is submitted that the Examiner has been **consistent** is rejecting the claims of the present application since the **first Non-Final Action dated 12-16-04**. The Examiner has been rejecting the claims over **Chan (US5486648), Goehlich (US6784371) and Belli (US6455769)** until **Non Final Action dated 12-7-08**. Then in the **Final Rejection dated 5/19/09**, issued a newly cited art **Hughey, US 5,043,438**.

Moreover, the Examiner indicated to Applicants at Examiner Interview on 1-15-09 that at least FIVE References, US20030060525, US6403889, US6282778, US20020189697, and US4204086 would cited in the rejection of the claims.

The Examiner did not use US20030060525, US6403889, US6282778, US20020189697, and US4204086 after Applicants argued against these prior art on 3/9/09. Rather, the Examiner cited a new reference **Hughey, US 5,043,438** in the Final Rejection dated 5/19/09 and included it in the evidence relied upon in Examiner Answer dated 2/18/10.

It is submitted that an Applicant can not expect to foresee whether or how Examiner would reject or review the claims based on Applicants' arguments, much more than expect the Examiner to **cite a newly cited art, after informing them that at least 5 references would be cited in the rejection of the claims**. This situation provides the Applicant with an **"element of surprise."** The Applicants did not have an opportunity to review the application and respond to the Final Rejection appropriately.

In the Final Rejection, the Examiner directed Applicants to Hughey and indicated that the shield of Hughey may comprise a layer of conducting shield wires 16 or braided shield or an enclosing metal sheet. Then the Examiner combined Hughey's teaching with Belli et al. and alleged that "it would have been obvious at the time the invention was made to modify the cable of modified Chan to comprise a shield configuration as taught by Belli." Applicants merely argued that Hughey is directed to an invention which "comprises" additional elements to form the water resistant cable because Applicants was **"surprised"** and **did not** have the opportunity to completely review the file.

Moreover, the Examiner **added** another **newly cited art** in the Examiner Answer and cited **Midner, US3,795,640**. Again, Appellants were not provided an opportunity to respond to the newly cited rejection on the Examiner Answer because as indicated in Office Action, filing an XOT was not allowed in filing a Reply Brief.

Finally, Applicants are perplexed with the Office Action of the Examiner. (see Final Rejection dated 5/19/09.

First, the Examiner asserted to the Examiner that US20030060525, US6403889, US6282778, US20020189697, and US4204086 will be used in the rejection of the claims at the Examiner Interview dated 1-15-09.

Second, the claims were objected because they were indefinite (according to the Final Rejection dated 5-19-09). The Examiner stated in Examiner Answer that the objection is petitionable.

Third, the Examiner issued a newly cited prior art Hughey, US 5,043,438 in the Final Rejection.

Fourth, the Examiner issued a second newly cited art Midner, US3,795,640 in the Examiner's Answer. The Appellant did **not amend** the claims. The issuance of a new prior art **was not triggered by any action by Appellant.**

A new prior art reference applied or cited for the **first time** in an examiner's answer generally will constitute a **new ground of rejection**. If the citation of a new prior art reference is necessary to support a rejection, it must be included in the statement of rejection, which would be considered to introduce a **new ground of rejection**. Even if the prior art reference is cited to support the rejection in a minor capacity, it should be positively included in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 (CCPA 1970).

It is submitted that Applicants were **not given** an opportunity to respond to the newly cited art in the Final Rejection and Examiner Answer. For the above reason, Applicants submit that the Petition be granted or provide an opportunity for Applicants to respond appropriately to the two newly cited art.

Respectfully submitted,

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